

REMARKS

The following issues remain outstanding in the present application:

- the drawings have been objected to;
- the specification has been objected to under 35 U.S.C. 132 for allegedly introducing new matter;
- claims 1-10 and 18-21 have been rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement;
- claims 1-4, 6, 7, 10 and 18-21 have been rejected under 35 U.S.C. 103;
- claim 5 has been rejected under 35 U.S.C. 103;
- claim 8 have been rejected under 35 U.S.C. 103; and
- claim 9 has been rejected under 35 U.S.C. 103.

Preliminary Remarks

Applicant's representative wishes to express his appreciation for the Examiner's cordial reception during the Office Interview conducted on April 20, 2004. The Examiner's comments and suggestions were very helpful in preparing this amendment and Applicant's representative wishes to express his appreciation for the Examiner's assistance.

Drawing Amendments

The drawings have been objected to and new drawings and proposed corrections have been required by the Examiner to avoid abandonment. Accordingly, new formal drawings are submitted herewith along with amendments to Fig. 1A and Fig. 4A. The requested amendments to the drawings are for the purposes of providing reference numerals for features depicted but not labeled in the drawings as filed.

Specification Amendments

The specification has been objected to under 35 U.S.C. 132 as allegedly introducing new matter into the disclosure. Specifically, the alleged new matter consists of material contained in the new paragraph submitted by Applicant in its December 22, 2003 Amendment. While Applicant does not acquiesce in this objection, the former paragraph has been cancelled and a new paragraph added in its place via this Amendment. No new matter has been added by the amendment to the specification.

Specifically, in the present amendment, Applicant has added a new paragraph to describe additional features of the invention depicted in Figures 1A and 4A of the application as filed. The text of the newly added paragraph is supported by the drawings and by the written material found on pages C3, D21 and D26 of Applicant's provisional application, Ser. No. 60/262,115, from which priority was claimed and which was incorporated by reference in its entirety into the present application. See Specification at page 1, In 4-9; page 7, In 1-7; and page 8, In 23-30. While Applicant remains convinced that the previously added paragraph was fully supported by the drawings and provisional application incorporated by reference, the paragraph has been cancelled to moot any conceivable new matter objection. The new paragraph added via this amendment has been drafted to more closely parallel the literal language found in Applicant's provisional application as suggested by the Examiner.

In view of the foregoing, Applicant respectfully submits that reconsideration and withdrawal of the outstanding objection to the specification under 35 U.S.C. 132 for allegedly introducing new matter is proper and such action is respectfully submitted.

35 U.S.C. 112

Claims 1-10 and 18-21 have been rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action states that "[I]t is not clear from the provisional application that the waste container is a feature of the claimed invention, and as labeled on the correction to figures 1A and 4A and as described in the new

paragraph to the specification." Applicant does not acquiesce in the rejection in view of the support for this feature found in Applicants' provisional application Ser. No. 60/262,115 which was incorporated by reference in its entirety into the present application and the drawings as filed. In any event, the waste container is not critical to the patentability of the invention and thus has been cancelled from claims 1-10 and 18-21, thereby mooting the present rejection. The waste container limitation is now a feature of only dependent claim 27 and claimed as a "wastewater bottle." Moreover, the specification has been amended to more closely parallel the exact language in the provisional application, which states with respect to Container Mounting Ring 2 *inter alia*, "[t]his ring will insert into a slot on the bottom section, back panel. A net will be fitted on the ring and a **wastewater bottle** will be place in the net." Finally, formal drawings have been submitted which more clearly depict the claimed wastewater bottle. Accordingly, reconsideration and withdrawal of the outstanding rejection of claims 1-10 and 18-21 under 35 U.S.C. 112, first paragraph, is proper and such action is respectfully requested. In addition, the feature of a "wastewater bottle" as claimed in new claim 27 has adequate written support in the application as filed and thus is also allowable in its present form.

35 U.S.C. 103

Claims 1-4, 6, 7, 10, and 18-21 have been rejected under 35 U.S.C. 103 as allegedly being unpatentable over Seidman in view of Bailey et al. Applicant respectfully submits that the claims are patentable over the art of record and respectfully traverses. Likewise, dependent claims 5, 8 and 9 have been rejected under 35 U.S.C. 103 as allegedly being unpatentable over Seidman in view of Bailey et al. in further view of Hoffmeister et al., Jones, or Beier et al. Given that the independent claims are patentable over the art of record and that these references fail to overcome the deficiencies in the Examiner's primary combination, Applicant submits these claims are therefore patentable and respectfully traverses the rejections.

In Applicant's December 22, 2003 Amendment, Applicant pointed out that Siedman, while disclosing a device having wheels and thus moveable, did not disclose or describe a "portable dental treatment system" as that term was defined in the specification. In response, the Examiner relying on the dictionary definition of "portable" noted that "[t]he prior art dental treatment system is portable in that it is shown to be 'capable of being carried *or* moved about.'" Applicant respectfully submits that the inventor as his own lexicographer has set forth a definition in the specification that clearly excludes those systems that are merely "movable" from those that are "portable." However, in an effort to advance the prosecution of the present application, the preamble has been amended to exclude systems that are "movable" but not "portable." Specifically, the preamble has been amended to claim "[a] portable dental treatment system configured to be compacted and bundled such that a relatively fit person can physically carry the portable dental system." Accordingly, Applicant respectfully submits that the prior art, while disclosing "movable" dental treatment systems having some aspects of the claimed invention, does not teach nor suggest "portable" dental treatment systems having the claimed features.

In order to make out a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1970). The mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggest the desirability of the combination. *In re Mills*, 16 USPQ.2d 1430 (Fed. Cir. 1990). Further, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983).

Applicant respectfully submits that independent claims 1 (and claims 2-10 and 27-28 depending therefrom) and 18 (and claims 19-21 depending therefrom) are patentable over the art of record. Specifically, Applicant respectfully submits that the Examiner is using impermissible hindsight in rejecting the claims. "It is impermissible to use the claimed invention as an instruction manual or 'template; to piece together the teachings of the prior art so that the claimed invention is

rendered obvious. . . . ‘One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988)). In this regard, the Examiner is using the Applicant’s specification to combine the features of portable dental systems and over-the-patient office dental systems to reach the claimed combination. However, this combination is precisely what Applicant’s invention is – a portable dental system which includes the advantageous features of an over-the-patient dental system. Before Applicant’s invention, the prior art failed to teach or suggest such a combination.

In rejecting the claims, the Examiner argues the “Seidman discloses a **portable** dental treatment system” comprising a dental bracket and other features of the claims. Seidman does not teach a “portable” system. Seidman teaches a dental system having a “fixed or mobile cabinet.” Seidman at 5. A reading of the reference indicates “mobile” as simply indicating the provision of wheels (see Fig. 1) on the cabinet so the unit can be moved around a dental office. This does not equate to the term “portable dental treatment system” set forth in Applicant’s specification:

“Portable dental treatment systems are dental treatment systems which have been designed such that they can be compacted and bundled so that a relatively fit person (e.g., a man or a woman) can physically carry the portable dental system.” Specification, p.1, ln 15-18.

As previously mentioned, the preamble of the claims has been amended to excluded devices which cannot be carried.

Applicant’s specification goes on to elaborate that portable systems are adapted for use in field environments or under conditions where there is insufficient power and/or sewer facilities to accommodate fixed or dental office-type systems. See Specification, p.1, ln 19 to p.2, ln 6. There is nothing in Seidman to teach or suggest the use of the dental unit as a “portable” system in the field or under conditions where power and/or sewer facilities are lacking.

Seidman is simply another example of a dental unit for use in an office-type environment.

The Examiner then relies upon Bailey et al. for teaching "a portable dental treatment system comprising a portable suction pump." Applicant agrees with characterization of Bailey et al. However, the Bailey et al. system suffers from the exact drawbacks Applicant's invention was intended to overcome. Bailey et al. only provides for "side-of-the-patient" delivery of dental service. The Bailey et al. portable system includes a housing with the dental tools mounted to a tool holder 27 (Fig. 2), 127 (Figs. 9 and 10) on the side of the housing. This is precisely the problem in the prior art sought to be overcome by the present inventor – devising a system which does not require dental surgeons or assistants to pull and return instruments from an area below or beside the patient on a dental chair. As clearly set forth in the Applicant's specification:

It has been discovered by the invention named herein (the inventor) that existing portable dental treatment systems place undue physical strain upon the providers of dental services (e.g., dental surgeons and/or dental technicians). In particular, it has been discovered by the inventor that existing portable dental treatment systems tend to provide delivery of dental services in a manner substantially different than the manner in which dental services are ordinarily provided in permanent (e.g., non-portable) dental operatories.

In permanent dental operatories, dental services are ordinarily provided to patients via what is known in the art as "over-the-patient" mode. In contrast, in virtually all related-art portable dental treatment systems, dental services are generally provided in what will be referred to herein as "side-of-the-patient" mode. That is, rather than the dental treatment system suspending dental instruments such that a dental patient chair (and hence a patient) can be positioned substantially below the dental instruments, in related-art portable dental treatment systems, the dental instruments are often positioned in such a way that the instruments are to the side of the dental patient chair (and hence the dental patient).

Dental surgery, even under the best of working conditions, is physically fatiguing in that it requires both physical strength and manual dexterity in order to provide efficient and safe dental treatment to a dental patient (e.g., having the physical strength to remove a temporary dental crown held in place with temporary dental cement, and the manual dexterity to remove the temporary dental crown without damaging adjacent teeth). Insofar as both physical strength and manual dexterity tend to degrade with physical fatigue, permanent dental operatories are designed such that dental services can be provided with a minimal of

physical strain on dental surgeons and/or dental technicians assisting dental surgeons. One aspect of such design of permanent dental operatories is over-the-patient delivery, which has been found empirically to minimize physical fatigue and strain on both dental surgeons and/or dental technicians assisting dental surgeons. The inventor has recognized that insofar as the working conditions in a portable dental operating room environment tend to be significantly degraded relative to a permanent dental operating room environment, it would be advantageous to have a portable dental treatment system which provides over-the-patient delivery of dental services in a fashion analogous to that utilized in permanent, or fixed, dental operating room environments. Specification, p.3 ln 18 to p. 4 ln 18.

Clearly, the Applicant's specification is being used as a roadmap to combine the advantageous features of over-the-patient dental operatory systems, such as Seidman, with the advantageous features of portable, self-contained systems, such as Bailey et al. However, realizing that a combination provides certain advantages using Applicant's claims as a template amounts to no more than impermissible hindsight. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 682, 16 U.S.P.Q.2d at 1432; see also *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references). It is well established that, even if all aspects of the claimed invention were individually known in the art, such is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). It is, therefore, incumbent upon the Examiner to provide some suggestion of the desirability of doing what the inventor has done in his formulation, imposition and maintenance of a rejection under 35 U.S.C. 103(a). "To support the conclusion that the claimed invention is directed to obvious subject matter,

either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Thus, for the reasons presented, the combination of Seidman and Bailey et al. is believed to be improper thereby rendering the rejection under 35 U.S.C. §103(a) improper. Accordingly, withdrawal of the rejection is respectfully requested.

In view of the foregoing, Applicant respectfully submits that the present invention as set forth in independent claims 1 and 18 are patentable over the art of record. With respect to the dependent claims, Applicant respectfully submits that if an independent claim is free of the art, then any claim depending therefrom is also free of the art. *In re Fine*, 5 USPQ.2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully submits that the present invention is patentable over the art of record.

CONCLUSION

Applicant respectfully submits that the present application is in condition for allowance, and early notice of the same is respectfully requested. Should the Examiner have any questions or comments, the Examiner is invited to contact Applicant's representative at the number indicated below.

Respectfully submitted,

CAHN & SAMUELS, LLP

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By: W.S. Bradley
William E. Bradley, Esq.
Reg. No. 42,355
Cahn & Samuels, LLP
2000 P St., NW, Ste. 200
Washington, D.C. 20036
Telephone: (202) 331-8777
Fax: (202) 331-3838



Appl. No.: 09/828,601
Amdt. Dated May 4, 2004
Reply to Final Office Action of March 4, 2004
Annotated Sheet Showing Changes

1/13

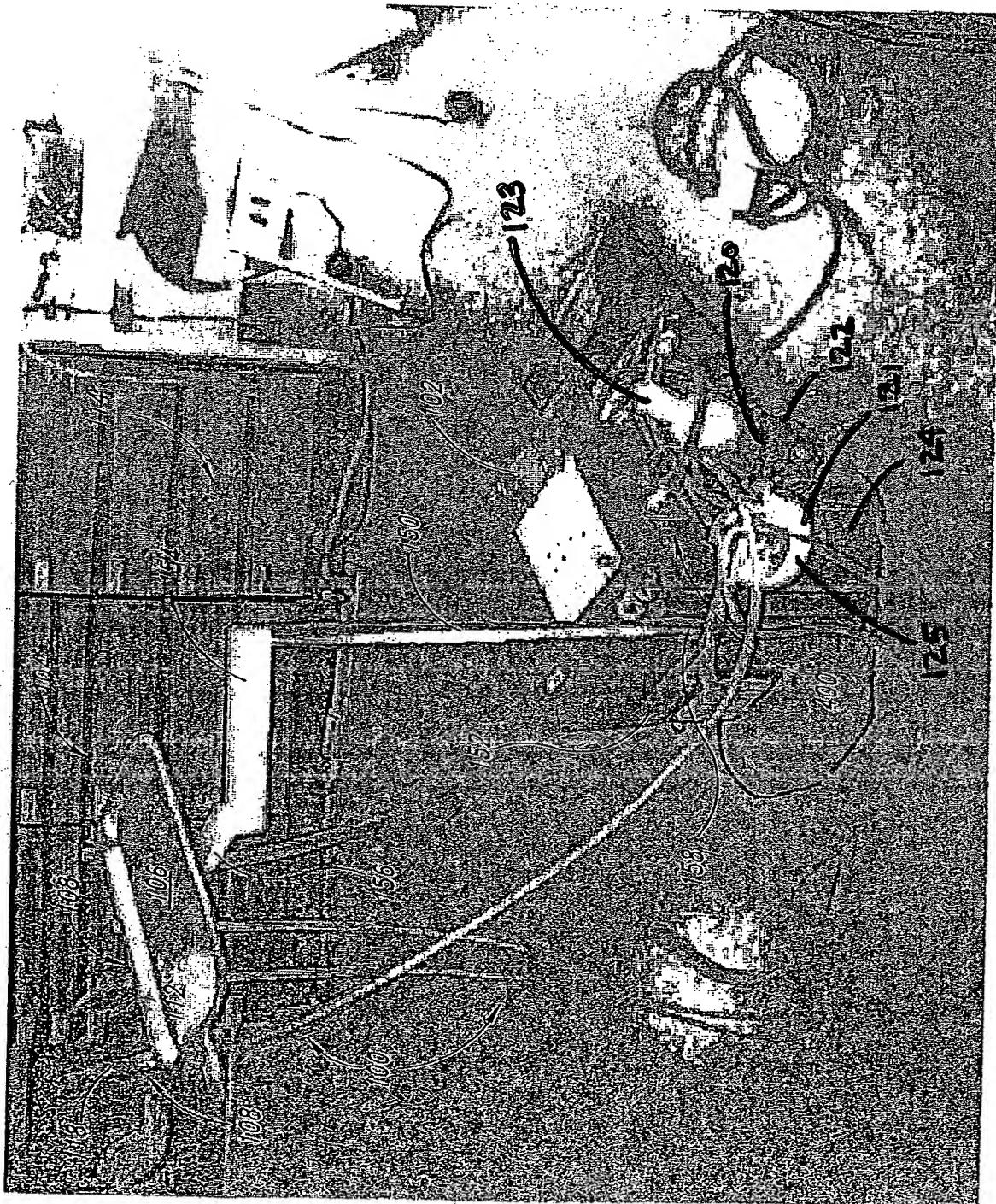


FIG. 1A



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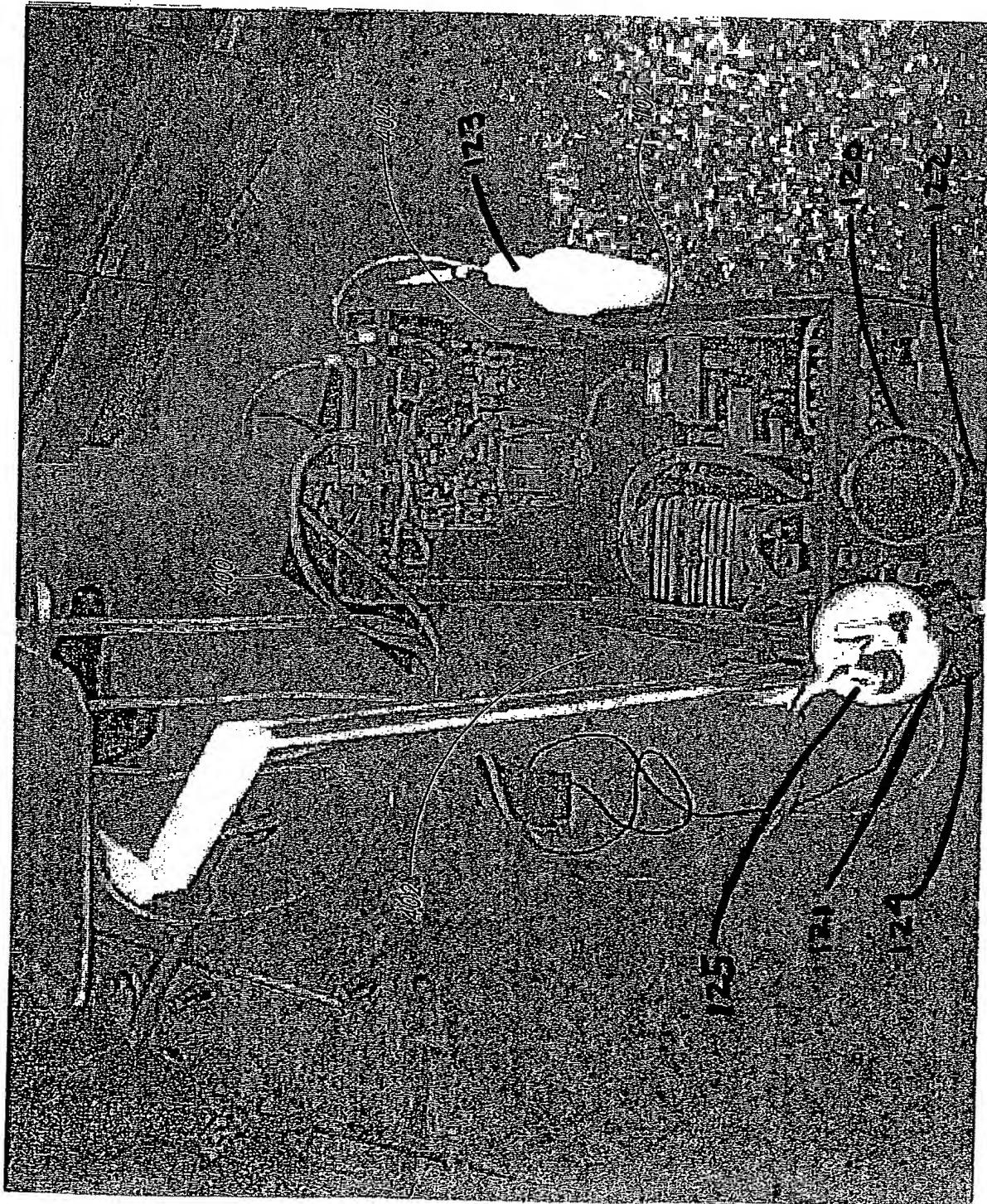


FIG. 4A